

## **REMARKS**

By the present amendment and remarks, Applicant respectfully requests reconsideration of the outstanding Office Action and allowance of the present application.

### **Summary of the Amendments**

By the foregoing amendment, claims 1 and 4 are amended, claims 2, 3 and 7 are canceled, whereby claims 1 and 4-6 remain pending. Of the pending claims, claim 1 is independent.

Applicants have amended claim 1 to further clarify the invention, wherein claims 2 and 3 have been canceled to incorporate recitations into claim 1. Support for the amendment to claim 1 can be found in the originally filed claims 2 and 3, and the originally filed specification. Applicant submits that no new matter has been added.

Further, any amendments to the claims which have been made in this response and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

### **Drawings**

Applicants thank the Examiner for acceptance of the drawings filed March 9, 2005.

**Claim of Priority**

Applicants thank the Examiner for acknowledging Applicants' claim of priority to Japanese Application No. 2002-282284.

**Information Disclosure Statement**

Applicants thank the Examiner for consideration of the Information Disclosure Statement filed June 9, 2005.

**Response to Claim Rejections****1. Response to Rejections under 35 U.S.C. § 102(b)**

Claims 1-7 are rejected under 35 U.S.C. § 102(b) as being anticipated by SHIBA (JP 2001323204A). The Office Action alleges that SHIBA teaches all the elements of claims 1-7.

In response to the anticipation rejections, Applicants note that a rejection under 35 U.S.C. § 102 can only be maintained if every element of the rejected claim is found in a single prior art document.

Applicants note that SHIBA fails to disclose every element of rejected claim 1. For example, SHIBA discloses generally, the use of hydroxides of alkali metal or alkaline earth metal compounds (see, e.g., paragraph [0039]). However, as a concrete example, SHIBA only discloses sodium hydroxide (see, e.g., Example 1, paragraph [0047]). Therefore, SHIBA fails to disclose at least Mg hydroxide, Mg oxide, Ca hydroxide, and Ca oxide (or equivalents) as

presently claimed.

Moreover, in contrast with independent claim 1, Applicants note that because SHIBA discloses only the concrete example using sodium hydroxide, SHIBA is silent with respect to technical differences between sodium hydroxide, and the bivalent metal compounds (*i.e.*, Mg and Ca, or equivalents) as presently claimed. Applicants note that the use of at least Mg hydroxide, Mg oxide, Ca hydroxide, and Ca oxide (or equivalents) provides superior gas barrier properties (*see, e.g.*, pages 7 and 21-26 of Applicants' specification), by providing, *inter alia*, low oxygen permeation characteristics.

Accordingly, for at least the above reasons, SHIBA fails to disclose every element of independent claim 1, and therefore the 35 U.S.C. § 102(b) rejection of claims 1 and 4-6 (claims 2, 3 and 7 being canceled) should be withdrawn.

With respect to dependent claims 4-6 as rejected under SHIBA, Applicants submit that because SHIBA do not disclose all the recitations of independent claim 1, claims 4-6 are therefore patentable because they depend from claim 1 which are also patentable, as demonstrated above.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 102(b) rejection of claims 1 and 4-6 as being unpatentable over SHIBA.

**2. Response to Rejections under 35 U.S.C. § 103(a)**

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Claims 1-7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over MIYAGAWA (JP 200202516A) and further in view of TOKYO (JP 57049431A).

Applicants respectfully request withdrawal of the obviousness rejections in view of the following remarks. Applicant respectfully submits that a *prima facie* case of obviousness is not established by the combination of MIYAGAWA and TOKYO for at least the following reasons. A *prima facie* case of obviousness requires:

- a) the motivation to combine the separate reference teachings,
- b) the presence of all claimed elements, and
- c) a reasonable expectation of success.

The Office Action fails to establish any of these requirements.

First, regarding motivation, to properly establish a *prima facie* case of obviousness, assuming, *arguendo*, that the rejection is based on a proper combination, the combined teachings must disclose all of the recitations of the rejected claims and the cited document(s) must contain some suggestion or motivation for such combination. Applicants respectfully submit that the rejection over MIYAGAWA in view of TOKYO fail to provide specific motivation to arrive at the claimed invention. Moreover, nothing in MIYAGAWA or TOKYO would direct one of ordinary skill in the art to arrive at Applicants' claimed semiconductor device. Additionally, Applicants respectfully submit that the motivation set forth in

the Office Action does not correct the deficiencies of MIYAGAWA, and as such, the motivation set forth in the Office Action is clearly misplaced and cannot be gleaned from either MIYAGAWA or TOKYO, or one of ordinary skill in the art. Mere statements that it would have been obvious to one of ordinary skill in the art without pointing to support in the cited document **is not sufficient** to satisfy the *prima facie* case of obviousness.

Second, regarding the presence of all claimed elements. Applicants respectfully submit that even if MIYAGAWA in view of TOKYO were to direct one of ordinary skill in the art to arrive at Applicant's claimed gas barrier layer, other aspects of the present invention would not necessarily be present. For example, MIYAGAWA discloses the use of sodium hydroxide as a neutralizer (Example 1), but fails to disclose or suggest the use of the claimed bivalent metal compounds. Moreover, while the Office Action alleges that the crosslinking agent is a metal complex that is at least divalent, Applicants respectfully submit that MIYAGAWA fails to disclose Mg hydroxide, Mg oxide, Ca hydroxide, and Ca oxide (or equivalents) as presently claimed.

Moreover, TOKYO fails to correct the deficiencies of MIYAGAWA. For example, while TOKYO discloses Ca hydroxide with Zn oxide, Ti oxide polyisocyanate, Al hydroxide, and dimethyl aluminum (see, e.g., Table 1), TOKYO is directed to a **completely non-analogous art** (*i.e.*, polymer applied to electrodes for attachment to skin). Therefore, Applicants respectfully submit that one having ordinary skill in the art would not have combined TOKYO with

MIYAGAWA. Thus, even if there was a proper motivation to combine TOKYO with MIYAGAWA, which there is not, the combination of TOKYO with MIYAGAWA is improper.

Therefore, in view of at least the above differences, the combination of MIYAGAWA and TOKYO fail to teach or suggest all the claimed elements in independent claim 1. Accordingly, Applicant respectfully submits that the Office bears the burden of showing the presence of all of these claimed elements, which it has not done.

Finally, regarding a reasonable expectation of success, despite the assertions in the Office Action, there would have been no expectation of success of achieving the specific recitations of the present claims. There is no reason to believe that Applicant's particularly claimed gas barrier layer would have resulted. In this regard, and as noted above, Applicant notes that TOKYO is directed to a completely non-analogous art (*i.e.*, polymer applied to electrodes for attachment to skin). Therefore, Applicants respectfully submit that one having ordinary skill in the art would not have combined TOKYO with MIYAGAWA, and likewise, there would be no reasonable expectation that a polymer typically applied to electrodes would be successful as a gas barrier layer applied to a polymer. Thus, even if there was motivation to combine TOKYO with MIYAGAWA, which there is not, the combination of TOKYO with MIYAGAWA is improper. Therefore, Applicants respectfully submit that such a gas barrier layer

would not have been obvious over the combination of MIYAGAWA in view of TOKYO.

With respect to dependent claims 4-6, Applicant submits that because the combination of MIYAGAWA in view of TOKYO does not disclose all the recitations of claim 1, claims 4-6 are therefore patentable because they depend from claim 1 which is also patentable, as demonstrated above.

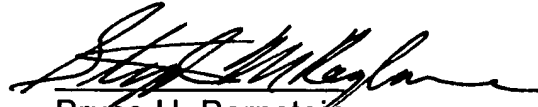
Therefore, in view of at least these points, Applicant respectfully submits that the claims are not obvious over MIYAGAWA in view of TOKYO, and it is respectfully requested that the 35 U.S.C. § 103 rejections of claims 1 and 4-7 be withdrawn.

### **CONCLUSION**

In view of the foregoing, it is submitted that none of the cited documents of record, either taken alone or in any proper combination thereof, anticipates or renders obvious the Applicant's invention, as recited in each of claims 1 and 4-7. In addition, the applied cited documents of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Respectfully Submitted,  
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July 24, 2006  
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